

REMARKS

Applicants have carefully reviewed and considered the current Office Action and the reference(s) cited therein. Claims 13, 32, and 36 are herein amended; No claims are herein canceled; and no claims are herein added. As a result, Claims 13, 14, 32, 33, and 36-45 are now pending in this application. Claim 36 is herein amended to include the word "address," which had been inadvertently left out of the claim.

Applicants thank the Examiner for the courtesy of a telephone interview on June 25, 2007. Upon being informed that the current Office was marked as both Final and Non-Final, the Examiner indicated that the Office Action was a Non-Final rejection. The undersigned expressed the opinion that the rejection under 35 U.S.C. §101 was inappropriate and pointed out that the Examiner did not consider all limitations (e.g., the inserting step) in making the rejection. In discussing the rejection of the claims under §101, the Examiner explained that Examiners are trained that if a claimed product executes a method, then they are to treat the claim as a method. During the interview, the undersigned also indicated to the Examiner that the primary reference itself (i.e., U.S. Patent Publication No. 2004/0128346) is not prior art and that the Figures and steps cited by the Examiner are not present in the provisional from which the primary reference claims priority.

Rejection of Claims 13, 14, 32, 33, and 36-45 under 35 U.S.C. §101

The Examiner has rejected Claims 13, 14, 32, 33, and 36-45 under 35 U.S.C. § 101. In support of this rejection, the Examiner states the following:

Referring to exemplary claim 13, a claim is statutory if it produces a "concrete, tangible, and useful result" See *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. As such an embodiment of the claim is that if there is no content associated with the page, then the claim does nothing. In this sense the result of the claim is the mere determination of whether or not a cache hit occurred, which does not provide a tangible or useful result. Correction is required.

Applicants respectfully traverse this rejection.

The Examiner has failed to consider limitations in the claims. For example, the Examiner makes no mention of the code segments of Claim 13 that insert a unique identifier into the address or the code segments that transmit the request to a server.

These code segments are present in every embodiment of the claims. The Examiner also does not take notice that the claimed code segments perform the determining step at the client, not at a cache server as is done in the cited primary reference. Similarly, the Examiner does not address Claim 32 as a whole, but instead selects a particular situation in which the method may execute.

Rejection of Claims 13, 14, 32, 33, and 36-45 under 35 U.S.C. §103

The Examiner has rejected Claims 13, 14, 32, 33, and 36-45 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2004/0128346 issued to Melamed et al. ("Melamed"). Applicants respectfully traverse the rejection.

Melamed is not prior art. The filing data of the present application (i.e., May 31, 2001) predates the filing date of Melamed (i.e., July 16, 2001). Melamed does claim priority from provisional application No. 60/218,559, filed July 17, 2000. However, the Examiner cites Figure 2 as well as steps 202, 212, and 216 in Melamed and this Figure and these steps are not present in the provisional application. That is, the Examiner appears to be relying on teachings in Melamed (which is not prior art) and these teachings are not present in the provisional application.

Applicants have amended Claims 13 and 32. These amendments are not made in response to the rejection because the rejection relies on a reference that is not prior art and is therefore not valid. Applicants note here that neither Melamed (regardless of whether prior art or not) nor Lambert teach the determining step that is performed at the client. Having the determining step performed at the client allows the client to make a determination as to whether or not to insert the unique identifier in response to specific user events such as when there is a "refresh" or a "back," for example. If the determining step were performed at a cache server (as in Melamed) or at an Internet Service Provider ("ISP") (as in Lambert), then the cache server or the ISP would have to be able to monitor the client computer for the occurrence of user events that require the insertion of the unique identifier.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. If the Examiner believes that a telephone conversation with the Applicants' representative would facilitate prosecution of this application in any way, the Examiner is cordially invited to telephone the undersigned at (508) 616-9660. If necessary, please apply any additional fees, or credit overpayments, to Deposit Account 50-3735.

Respectfully submitted,

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